

Current NO:3 [and which hybridizes under low stringency conditions to a reverse complement of SEQ ID NO:3].

Claim 50, Line 1, delete "Claim 43" and insert therefor --any one of Claims 44, 45 or 46--.

Please add the following new Claim 51 as follows:

51. The nucleic acid of Claim 47 wherein said nucleic acid hybridizes to a reverse complement of SEQ ID NO:3 under low stringency conditions.--

REMARKS

In the Office Action dated August 18, 1999, Claims 28, 30, 33, 43, and 47-50 have been rejected under 35 U.S.C. §112, first paragraph as allegedly lacking enabling support. Claims 28, 30, 33, and 43-50 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. Claim 36 has also been rejected as allegedly indefinite¹. Claim 49 has been objected to under 37 C.F.R. §1.75(c) as allegedly in improper dependent form. Claims 28, 30, 43 and 48 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by Leung, et al. (1989) Science, 246:1306-1309 (hereinafter "Leung, et al."). Claims 44 and 46 have been rejected under 35 U.S.C. §102(e) as allegedly anticipated by Eriksson, et al., U.S. Patent No. 5,607,918 (hereinafter Eriksson, et al.).

¹ Claim 36 was cancelled without prejudice in an Amendment filed on July 6, 1999. Accordingly, the Examiner's rejection is moot and withdrawal thereof is requested.

In response to the above rejections, applicants have amended the claims, which when considered with the accompanying comments is deemed to place the present application in condition for allowance.

The Examiner has rejected Claims 28, 30, 33, 43 and 47-50 under 35 U.S.C. §112, first paragraph as allegedly lacking enabling support. The Examiner specifically alleges that "the claims are not limited to nucleic acid molecules encoding a protein with a specific amino acid sequence, and actually do not require the nucleic acid to even encode a protein". The Examiner further alleges that the specification fails to provide sufficient examples in the specification to enable "VEGF-like" proteins.

In the first instance, applicants respectfully submit that the claims, as amended, no longer recite "VEGF-like" proteins in view of the cancellation of the Claims 43, 48 and 49. Moreover, there is no requirement in the patent law that a claim directed to an isolated nucleic acid must recite the protein which is encoded thereby. Applicants submit that the claims, as amended, properly recite isolated nucleic acids encoding or complementary to nucleic acid sequences which encode polypeptides of the present invention.

The Examiner also alleges that the "application fails to provide a written description of the species or genus which are encompassed by the claimed...nucleic acids which hybridize

to SEQ ID NO:3 under low stringency conditions...". Applicants respectfully submit that the specification adequately describes examples of nucleic acids capable of hybridizing to SEQ ID NO:3. Specifically, nucleic acids corresponding to SEQ ID NOS:5, 7 and 9 are respectively 98.9, 95.1 and 99.2 identical (at the nucleic acid level) to SEQ ID NO:3. In this regard, applicants submit that SEQ ID NOS:5, 7 and 9 should hybridize under low stringency conditions to a reverse complement of SEQ ID NO:3. The Examiner's attention is respectfully directed to the specification at Page 14, Example 1 wherein several cDNA clones were obtained by hybridization to SEQ ID NO:3. Accordingly, the rejections of Claims 28, 30, 33, 43 and 47-50 under 35 U.S.C. §112, first paragraph are overcome and withdrawal thereof is respectfully requested.

Claims 28, 30, 33 and 43-50 have been rejected under 35 U.S.C. §112, second paragraph as allegedly indefinite. The Examiner alleges that "the use of percent identity or similarity is indefinite without a recitation of a specific algorithm for calculating percent identity". Applicants submit that the U.S. Patent and Trademark Office has recently altered its position with respect to rejections of claims reciting percent identity or similarity under 35 U.S.C. §112, second paragraph. Specifically, it is applicants understanding that such rejections are no longer proper and withdrawal thereof is respectfully requested.

Claims 43-46 have been rejected under 35 U.S.C. §112, second paragraph as allegedly indefinite because (according to the Examiner) "they should be claiming the nucleic acid molecule which is the actual invention, not the sequence of the nucleic acid molecule". In an effort to expedite favorable prosecution and in accordance with the Examiner's recommendation, Claims 43-46 have been amended to replace "sequence" with "nucleic acid".

Accordingly, the rejections of Claims 28, 30, 33, and 43-50 under 35 U.S.C. §112, second paragraph are overcome and withdrawal thereof is respectfully requested.

Claim 49 has been objected to under 37 C.F.R. §1.75(c) as allegedly in improper dependent form. Applicants have cancelled Claim 49 without prejudice thereby rendering the Examiner's rejection moot and withdrawal thereof is respectfully requested.

Claims 28, 30, 43 and 48 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by Leung, et al. The Examiner alleges that the claims require a "nucleic acid which encodes a polypeptide which comprises an amino acid of SEQ ID NO:2 (or has at least about 90% similarity thereto)". In an effort to expedite favorable prosecution, Claims 43 and 48 have been cancelled without prejudice, Claims 28 and 30 have been amended accordingly. Therefore, withdrawal of the rejection of

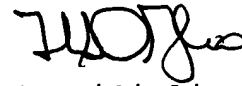
Claims 28, 30, 43 and 48 under 35 U.S.C. §102(b) is respectfully requested.

Claims 44 and 46 have been rejected under 35 U.S.C. §102(e) as allegedly anticipated by Eriksson, et al. The Examiner alleges that "Eriksson, et al. teach a nucleic acid (SEQ ID NO:11) which comprises the nucleotide sequence of SEQ ID NO:4 and 10 of the instant claims". Applicants note that SEQ ID NO:11 of Eriksson, et al. is not a nucleic acid but a 188 amino acid protein from a human fibrosarcoma. SEQ ID NO:4 (Claim 44) of the instant invention is a 207 amino acid protein encoded by SEQ ID NO:3 (the nucleotide sequence of SOM175). SEQ ID NO:10 (Claim 46) of the instant invention is a 101 amino acid sequence comprising SOM175 absent exon 4. Applicants therefore submit that the Examiner has failed to establish a prima facie case of anticipation under 35 U.S.C. §102(e). Moreover, having reviewed the parent application 08/397,651, Eriksson, et al. only provides seven sequences, none of which appear to constitute SEQ ID NO:11. Therefore, the rejection of Claims 44 and 46 under 35 U.S.C. §102(e), is overcome and withdrawal thereof is respectfully requested.

Thus, in view of the foregoing amendments and remarks, it is respectfully submitted that the present

application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,



Frank S. DiGiglio
Registration No. 31,346

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

PIB:bb